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10/686,345	10/14/2003	Dale W. Malik	190250-1230	7192
83658 7590 03/24/2009 AT & T Legal Department - WS Attn: Patent Docketing Room 2A-207 One AT & T Way Bedminster, NJ 07921				
			EXAMINER KIM, HEE SOO	
			ART UNIT 2457	PAPER NUMBER
			MAIL DATE 03/24/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/686,345

**Applicant(s)**

MALIK ET AL.

**Examiner**

HEE SOO KIM

**Art Unit**

2457

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is responsive to RCE filed on March 12<sup>th</sup>, 2009.

Claims 1~22 are pending examination.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/12/09 has been entered.

#### ***Response to Arguments***

Applicant's arguments filed 3/12/09 have been fully considered but they are not persuasive.

In response to Applicant's argument on (Pg. 4, ¶2) that Hickey does not teach or suggest "wherein the group email message includes an access indicator for each member of the group, the access indicator configured to indicate which members of the group have accessed the group email message." Examiner respectfully disagrees. Hickey taught status indicators "showing the current status (e.g., New, Read, Answered, Moved, etc.) of an email message in the group mailbox". Hickey further taught that such status indicators allow the members of the group to obtain the status to messages within the group email folder regarding the other members of the group [¶79].

Applicant's arguments see Pg. 5 and 6, filed 3/12/09, with respect to the rejection(s) of claim(s) 6, 15, and 16 under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made.

***Claim Rejections - 35 USC § 101***

Claim 18 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 18 is a system claim reciting "a user profile", "a user email folder", "a user IM account", and "an interface" all of which fails to specifically disclose to be a part of a physical device and to one of ordinary skill can be implemented as software routines. Therefore renders the system at most as software per se, failing to fall within a statutory category.

Accordingly, the claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be

statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, do not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”).

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1~5, 7~14, and 17~22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelman et al. hereinafter Appelman (U.S 6,912,564) in view of Hickey et al. hereinafter Hickey (U.S 2002/0087646).

#### Regarding Claim 1,

Appelman taught a communication method comprising the steps of:

providing a user profile having a collection of properties related to a user email folder, the user profile further having a collection of properties related to a user instant messaging (IM) account (Col. 10, Ln. 30~56, subscriber profile data of IM host complex 590; Profile server 5912 may communicate with servers in the OSP host complex 580 to share profile data; Col. 5, Ln. 40~45, OSP host complex supports email services,

discussion groups, and other services; Col. 12, Ln. 53~65, folder attributes set by subscriber of the host system);

defining properties of the user email folder using the user profile (Col. 12, Ln. 53~65); and

defining properties of the user IM account using the user profile (Col. 10, Ln. 30~40); and

providing at least one interface for displaying the user profile, including the defined properties of the user email folder and the defined properties of the user IM account (Col. 10, Ln. 30~40, profile server is used to enter, retrieve, edit, manipulate or process subscriber profile data implying an interface is displayed to the user).

While Appelman taught an interface for users being able to set their email and instant messaging preferences in the subscription profile data, Appelman did not explicitly teach:

wherein the interface is further configured to provide at least one group email message corresponding to at least one group email folder, the group email folder configured such that members of a group associated with the group email folder have access to the group email message, wherein the interface is further configured to provide an option to provide at least one user-specific email, the user specific email being different than the group email message, and wherein the group email message includes an access indicator for each member of the group, the access indicator configured to indicate which members of the group have accessed the group email message.

In an analogous art, Hickey taught a system and method for providing a group electronic mailbox that enables multiple users to work collaboratively and/or simultaneously with one or more communications received in the mail box (see Abstract), in which each electronic communication includes a status indicator that conveys the status regarding the associated one or more electronic mails to the members of the group, in which the status information includes read information, and also in which such status changes in response to acts of each member of the group. The system of Hickey provides status information including read information, acted upon information, and replied information [¶43]. Hickey further taught status indicators "showing the current status (e.g., New, Read, Answered, Moved, etc.) of an email message in the group mailbox". Hickey further taught that such status indicators allow the members of the group to obtain the status to messages within the group email folder regarding the other members of the group [¶79].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to combine the "references" of Hickey (as well as the other relied upon portions of Hickey) into the teachings of Appelmann, in order to indicate to each member of the group, through the use of the references, that a group message is stored in the group email folder and further allow members of the group to know whether or not such emails have been reviewed, acted upon, or replied to thereby allowing the members to selectively operate on such electronic communications (Hickey: [¶11]) as well as notifying members or users of the group of any changes in status information of the received electronic communications, so that when a member of

the group takes action on an received email, other members of the group can see what has been done (Hickey: ¶[16]).

Regarding Claim 2,

Appelman taught the step of providing the user profiles comprises:

assigning a user profile to a user (Col. 10, Ln. 30~56);

permitting the user assigned to the user profile to have access to the at least one user email folder associated with the user profile (Col. 10, Ln. 30~56, Col. 12, Ln. 53~65); and

While Appelman taught an interface for users being able to set their email and instant messaging preferences in the subscription profile data, Appelman did not explicitly teach permitting the user assigned to the user profile to have access to the group email folder.

In an analogous art, Hickey taught a system and method for providing a group electronic mailbox that enables multiple users to work collaboratively and/or simultaneously with one or more communications received in the mail box (see Abstract), and in addition to each user typically having an individual mailbox as well as access to the group electronic mailbox ¶[36].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to combine the "references" of Hickey (as well as the other relied upon portions of Hickey) into the teachings of Appelman, in order to indicate to each member of the group, through the use of the references, that a group message is stored in the group email folder. See motivation above.

Regarding Claim 3,



Appelman taught a communication method comprising the steps of:  
assigning a user profile to a user (Col. 10, Ln. 30~56);  
associating a user email folder with the user profile (Col. 12, Ln. 53~65); and  
associating a user instant messaging (IM) account with the user profile (Col. 10, Ln. 30~56); and

While Appelman taught an interface for users being able to set their email and instant messaging preferences in the subscription profile data, Appelman did not explicitly teach:

providing at least one interface for displaying the user profile, including the defined properties of the user email folder and the defined properties of the user IM account,

While Appelman taught an interface for users being able to set their email and instant messaging preferences in the subscription profile data, Appelman did not explicitly teach:

wherein the interface is further configured to provide at least one group email message corresponding to at least one group email folder, the group email folder configured such that members of a group associated with the group email folder have access to the group email message, wherein the interface is further configured to provide an option to provide at least one user-specific email, the user specific email being different than the group email message, and wherein the group email message includes an access indicator for each member of the group, the access indicator

configured to indicate which members of the group have accessed the group email message.

In an analogous art, Hickey taught a system and method for providing a group electronic mailbox that enables multiple users to work collaboratively and/or simultaneously with one or more communications received in the mail box (see Abstract), in which each electronic communication includes a status indicator that conveys the status regarding the associated one or more electronic mails to the members of the group, in which the status information includes read information, and also in which such status changes in response to acts of each member of the group. The system of Hickey provides status information including read information, acted upon information, and replied information [¶43]. Hickey further taught status indicators "showing the current status (e.g., New, Read, Answered, Moved, etc.) of an email message in the group mailbox". Hickey further taught that such status indicators allow the members of the group to obtain the status to messages within the group email folder regarding the other members of the group [¶79].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to combine the "references" of Hickey (as well as the other relied upon portions of Hickey) into the teachings of Appelman, in order to indicate to each member of the group, through the use of the references, that a group message is stored in the group email folder and further allow members of the group to know whether or not such emails have been reviewed, acted upon, or replied to thereby allowing the members to selectively operate on such electronic communications

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(Hickey: ¶11) as well as notifying members or users of the group of any changes in status information of the received electronic communications, so that when a member of the group takes action on an received email, other members of the group can see what has been done (Hickey: ¶16).

Regarding Claim 4,

Appelman taught further comprising:

defining properties associated with the user email folder as a function of the user profile (Col. 12, Ln. 53~65).

Regarding Claim 5,

Appelman taught defining properties associated with the user email folder comprises:

assigning a user name associated with the user (Col. 8, Ln. 59~66); and

assigning a password associated with the user name (Col. 8, Ln. 59~66).

Regarding Claim 7,

Appelman taught defining properties associated with the user email folder comprises:

assigning a collection of email folders to the user (Col. 11, Ln. 45~47).

Regarding Claim 8,

Appelman taught assigning the collection of email folders to the user comprises:

storing post office protocol 3 (POP3) server information for each email folder in the collection of email folders (Col. 5, Ln. 47~52).

Regarding Claim 9,

Appelman taught assigning the collection of email folders to the user comprises:

storing simple mail transfer protocol (SMTP) server information for each email folder in the collection of email folders (Col. 5, Ln. 47~52).

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Regarding Claim 10,

Appelman taught properties associated with the user email folder comprises:

storing email filter settings (Col. 12, Ln. 53~65).

Regarding Claim 11,

Appelman taught defining properties associated with the user email folder comprises storing an address book associated with the user (Col. 14, Ln. 15~23).

Regarding Claim 12,

Appelman taught storing the address book associated with the user comprises assigning address book settings to the address book (Col. 14, Ln. 15~23).

Regarding Claim 13,

Appelman taught further comprising:

defining properties associated with the user IM account as a function of the user profile (Col. 10, Ln. 30~40).

Regarding Claim 14,

Appelman taught defining properties associated with the user IM account comprises:

assigning a user name associated with the user (Col. 8, Ln. 59~66); and

assigning a password associated with the user name (Col. 8, Ln. 59~66).

Regarding Claim 17,

Appelman taught storing a contact list associated with the user (Col. 10, Ln. 30~40).

Regarding Claim 18,

Appelman taught a communication system comprising:

a user profile (Col. 10, Ln. 30~56);

a user email folder associated with the user profile (Col. 12, Ln. 53~65); and

a user instant messaging (IM) account associated with the user profile Col. 10, Ln. 30~56); and

an interface for displaying the user profile, including the defined properties of the user email folder and the defined properties of the user IM account (Col. 10, Ln. 30~40, profile server is used to enter, retrieve, edit, manipulate or process subscriber profile data implying an interface is displayed to the user).

While Appelman taught an interface for users being able to set their email and instant messaging preferences in the subscription profile data, Appelman did not explicitly teach:

wherein the interface is further configured to provide at least one group email message corresponding to at least one group email folder, the group email folder configured such that members of a group associated with the group email folder have access to the group email message, wherein the interface is further configured to provide an option to provide at least one user-specific email, the user specific email being different than the group email message, and wherein the group email message includes an access indicator for each member of the group, the access indicator configured to indicate which members of the group have accessed the group email message.

In an analogous art, Hickey taught a system and method for providing a group electronic mailbox that enables multiple users to work collaboratively and/or simultaneously with one or more communications received in the mail box (see Abstract), in which each electronic communication includes a status indicator that

conveys the status regarding the associated one or more electronic mails to the members of the group, in which the status information includes read information, and also in which such status changes in response to acts of each member of the group. The system of Hickey provides status information including read information, acted upon information, and replied information [¶43]. Hickey further taught status indicators "showing the current status (e.g., New, Read, Answered, Moved, etc.) of an email message in the group mailbox". Hickey further taught that such status indicators allow the members of the group to obtain the status to messages within the group email folder regarding the other members of the group [¶79].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to combine the "references" of Hickey (as well as the other relied upon portions of Hickey) into the teachings of Appelman, in order to indicate to each member of the group, through the use of the references, that a group message is stored in the group email folder and further allow members of the group to know whether or not such emails have been reviewed, acted upon, or replied to thereby allowing the members to selectively operate on such electronic communications (Hickey: [¶11]) as well as notifying members or users of the group of any changes in status information of the received electronic communications, so that when a member of the group takes action on an received email, other members of the group can see what has been done (Hickey: [¶16]).

Regarding Claim 19,

Appelman taught the user profile is configured to define properties associated with the user email folder (Col. 12, Ln. 53-65).

Regarding Claim 20,

Appelman taught the properties associated with the user email folder include at least an email filter setting (Col. 12, Ln. 53~65).

Regarding Claim 21,

Appelman taught the user profile is configured to define properties associated with the user IM account (Col. 10, Ln. 30~40).

Regarding Claim 22,

Appelman taught the properties associated with the user IM account include at least a contact list (Col. 10, Ln. 30~40).

Claims 6, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelman in view of Hickey and further in view of 'Official Notice'.

Regarding Claims 6 and 15,

Appelman taught substantially all the limitations of claims 4 and 13 however, failed to specifically teach defining properties associated with the user email folder comprises: assigning a user type associated with the user.

Examiner takes 'Official Notice' that it was well-known to one of ordinary skill in the art for assigning user type associated with a user in a email environment as it would provide secure email communication between known and unknown users in the network.

Regarding Claim 16,

Appelman taught substantially all the limitations of claims 4 and 13 however, failed to specifically teach defining properties associated with the user IM account comprises: assigning a collection of IM accounts to the user.

Examiner takes 'Official Notice' that it was well-known to one of ordinary skill in the art for assigning a collection of IM accounts to the user as it would allow a user in one IM application to communicate with other users using different IM applications without the need to install separate IM applications.

### ***Conclusion***

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HEE SOO KIM whose telephone number is (571)270-3229. The examiner can normally be reached on Monday - Thursday 8:00AM - 5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. K./  
3/18/09

/ARIO ETIENNE/  
Supervisory Patent Examiner, Art Unit 2457